

Appl. No.: 10/689,465  
Amdl. dated 03/03/2006  
Reply to Office action of November 4, 2005

### **REMARKS/ARGUMENTS**

The Applicants initially acknowledge with appreciation the telephone interview granted to the undersigned by Examiner Gushi on February 21, 2006. In light of the interview and the following amendments and remarks, reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as presented are earnestly solicited. Claims 9, 11-23, and 25-27 are currently pending. In response to the Office Action mailed November 4, 2005, Claims 9 and 18 have been amended to further clarify the subject matter being claimed. The amendments to the pending claims find support throughout the Specification and the Figures, and no new matter has been added. Accordingly, it is believed that the claims now define patentable subject matter over the prior art cited by the Examiner and notice to such effect is requested at the Examiner's earliest convenience.

#### **Claim Rejections – 35 U.S.C. §103**

Claims 9, 11-13, 17-22, 26, and 27 were rejected in the Office Action as being unpatentable over U.S. Patent No. 3,988,052 to Mooney et al. in view of U.S. Patent No. 4,189,198 to Reichman, U.S. Patent No. 4,210,374 to Churla, and U.S. Patent No. 4,806,108 to Meinhardt, citing *In re Harza*, 274 F.2d 669 (CCPA 1960). Claims 14 and 23 were also rejected as being unpatentable over the Mooney '052, Reichman '198, Churla '374, and Meinhardt '108 patents in further view of U.S. Patent No. 2,116,776 to Bondeson. Claims 16 and 26 were rejected as being unpatentable over the Mooney '052, Reichman '198, Churla '374, and Meinhardt '108 patents in further view of U.S. Patent No. 4,159,859 to Shemtov. Claims 15 and 25 were rejected as being unpatentable over the Mooney '052, Reichman '198, Churla '374, and Meinhardt '108 patents in further view of U.S. Patent No. 5,816,844 to Perera. In response, Claims 9 and 18, upon which Claims 11-17, 19-23, and 25-27 depend, have been amended to provide further clarification of the claimed subject matter. That is, Claims 9 and 18 have been amended to recite that the trough is integral with the top clamping member. These amendments find support throughout the Specification and Drawings, and no new matter has been added.

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Independent Claim 9 recites a clamping apparatus for electrically connecting at least a first ground wire to a grounding member. Such a clamping apparatus comprises a bottom clamping member comprising a bottom medial portion and first and second threaded holes on first and second sides of the bottom medial portion for accepting first and second screws, respectively, wherein the first and second threaded holes are disposed along first and second longitudinal axes, respectively. A top clamping member is discrete with respect to and cooperates with the bottom clamping member and comprises a top medial portion for cooperation with the bottom medial portion to define a grounding member axis, wherein the top clamping member comprises first and second holes on first and second sides, respectively, of the top clamping member for alignment with the first and second threaded holes of the bottom clamping member. A trough comprises a base wall and opposing first and second side walls, wherein the trough is integral with the top clamping member opposite the bottom clamping member. The first side wall defines a threaded hole for receiving a set screw in threaded engagement therewith, wherein the threaded hole extends along a third longitudinal axis through the first side wall and toward the second side wall. The third longitudinal axis intersects at least substantially perpendicularly with at least one of the first and second longitudinal axes. The trough defines an opening between the first and second side walls for receiving a first ground wire. The opening further defines a ground wire axis parallel to the grounding member axis, whereby the first ground wire can be secured in the trough against the second side wall by the set screw.

Independent Claim 18 is directed to a clamping apparatus for electrically connecting at least a first ground wire to a grounding member. Such a clamping apparatus comprises a bottom clamping member comprising a bottom medial portion and first and second threaded holes on first and second sides of the bottom medial portion receiving first and second screws, respectively, wherein the first and second screws are disposed along first and second longitudinal axes, respectively. A top clamping member is discrete with respect to and cooperates with the bottom clamping member and comprises a top medial portion for cooperation with the bottom medial portion to define a grounding member axis, wherein the top clamping member comprises first and second holes on first and second sides, respectively, of the top clamping

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member receiving the first and second screws. A trough comprises a base wall and opposing first and second side walls, wherein the trough is integral with the top clamping member opposite the bottom clamping member. The trough defines an opening between the first and second side walls, wherein the opening further defines a ground wire axis parallel to the grounding member axis. A threaded hole is defined by the first side wall for threadedly engaging a set screw disposed along a third longitudinal axis, with the third longitudinal axis intersecting at least one of the first and second longitudinal axes above the first or second screw.

The Mooney '052 patent discloses an electrical conduit grounding clamp device 10 having a pair of complementary upper and lower cooperating first and second clamp members 13 and 14, a pair of clamp members connecting screws 16 and 17 and a ground cable clamping screw 18. The first clamp member 13 is formed by stamping and includes a longitudinally extending flat web 19 shaped to provide a medial crown portion 15, having a horizontal flat top section 20 and side sections 21 and 22 oppositely diverging downwardly from the opposite side edges of top section 20, the side sections 21 and 22 terminating at their bottom edges in horizontal coplanar wings 23 and 24. The wing 24 has a bore formed therein engaged by the screw 17. The wing 23 has a bore formed therein engaged by screw 16, which bore meets a transversely extending arcuate slot 27 extending to the edge of web 19 through the corresponding flange 26. Formed from the side section 21 is a relatively short upwardly projecting vertical leg 29 joined to the crown top 20 by a rounded edge end having a saddle shaped top edge 30. Further, formed from the side section 22 and wing 24 is a relatively long upwardly projecting vertical leg 33 joined to the crown top 20 by a rounded edge opposite the junction thereof with leg 29. A horizontal lug or arm 34 projects toward leg 29 from the top edge of leg 33 and is joined thereto by a curved edge and is above the level of the top edge 30 of leg 29 and overlies the crown top section 20. The arm 34 has a tapped vertical bore engaged by the cable clamping screw 18. The confronting edges of arm 29 and leg 34 are spaced apart a distance somewhat greater than the diameter of the grounding cable 11.

The Reichman '198 patent discloses a conduit grounding wire coupling device 10 which includes a conduit coupling collar 11, a cable or wire clamp member 12 and a coupling collar

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clamp member assembly locking screw 13. The collar member 11 is provided on its outer peripheral surface with a plurality of regularly circumferentially spaced radially projecting shallow rectangular protuberances or projections 17 having flat outer faces 18 parallel to planes tangent to the outer face of body member 14. One or more protuberances 17 have central threaded radial bores 19 formed therein and have formed in their outer faces 18 a plurality of grooves 20 of triangular transverse cross section extending diametrically of the respective bores 19. The bores 19 function to couple a clamp member 12 to collar 11. The clamp member 12 comprises a body member 22 including a longitudinally extending rear wall having a flat planar outer face 24 and outwardly projecting upper and lower transverse arms 26 and 27 respectively, upper arm 26 being along the top of rear wall 23 and of the same width thereof and lower arm 27 being above the bottom of rear wall 23 and likewise being of the same width thereof. The section of rear wall 23 below lower arm 27 defines a tab section, the sides of the lower half of which converge downwardly. The arm 27 terminates at its outer end in a curved upwardly directed lip 29. A threaded vertical bore is centrally formed in upper arm 26 and engages the threaded shank 30 of a clamp adjusting screw 32 having a slotted hex head 33. A laterally extending horizontal upper jaw member 34 is coupled to the lower end of threaded shaft 30 so that rotation of screw 32 in one or the other direction lowers or raises upper jaw member 34 relative to the lower jaw member defining lipped arm 27 to close or open the clamp member 12 respectively. In the assembled condition, the rear face of tab section 28 is superimposed on a face 18 of a grooved protuberance 17 with the ridge 37 engaging a selected groove 20 depending on the desired orientation of clamp member 12 and the bores 19 and 36 being in coaxial alignment. **Bolt 13 carrying a washer 39 engages aligned bores 19 and 36 and is tightened to releasably rigidly lock the coupling collar 11 and clamp member 12 in the preselected or desired angular relationship.** The angular relationship between coupling collar 11 and wire clamp member 12 may be adjusted merely by loosening bolt 13, turning clamp member 12 to bring ridge 37 into registry with a selected groove 20 and then tightening bolt 13.

The Churla '374 patent discloses a set-screw bushing comprising a bushing body 22, for being received on a pipe, and clamping means 24 secured thereto and formed as an integral unit. The clamping means 24 comprises a c-shaped block 30 defining a mouth 32. The mouth 32 is

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adapted to receive an electrical conductor 38 longitudinally therein (perpendicularly to the pipe) and to clamp the conductor into place. The bottom of the mouth forms a curved seat 40 for the conductor 38. The edge of the seat is in the form of an upwardly projecting lip 42. The portion 44 of the c-shaped block disposed over the seat 40 includes a threaded opening 46 therein. A threaded lug 48 extends through the opening 46 into the mouth 32 and toward the seat 40. The free end 52 of the lug 48 is adapted to clamp the conductor between itself and seat 40 to form an electrical connection.

The Meinhardt '108 patent discloses a grounding bushing 10 comprising an annular band 11 about a central axis coinciding with the axis of a conduit on which the grounding bushing 10 is used. The bushing 10 has a plurality of raised bosses 15 positioned to the exterior of surface 13, and having upper planar surfaces 16 which incline at an angle of inclination selected to provide a tilt or inclination for easy access to set screws that thereafter mount in threaded openings 20 that are provided in each of the bosses 15. At least one of the selected ears 15 is positioned so that a grounding lug indicated at 25 can be mounted on the surface 16. The lug 25 has a bottom surface 26 that mates with surface 16 and a receptacle 27 adjacent one side thereof opening through a passageway 28 open to the front of the lug. The lug 25 has a throat portion 30 that has a passageway 31 therethrough for receiving rotatably a screw 32. The lug 25 has an overhanging lip 35 that overlies the passageway 28 and this lip 35 has a screw 36 threaded therethrough to engage and bear against a grounding wire 40 that is positioned in the receptacle 27. The screw 36 is parallel to screw 32.

The Applicants first note that the Federal Circuit has consistently stated that a finding of obviousness requires a specific teaching, motivation, or suggestion to combine the teachings of individual items of prior art. See, e.g., *In Re Sang Su Lee*, No. 00-1158 (Fed. Cir. January 18, 2002) (actual question of motivation to combine is material to patentability and could not be resolved on subjective belief and unknown authority); *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine is an essential evidentiary component of an obviousness holding); *In re Frueh*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (Examiner can satisfy burden of obviousness in light of combination only by showing some objective teaching leading to the combination); and *In re*

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*Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (evidence of teaching or suggestion essential to avoid hindsight).

MPEP §2141 explicitly states that, when “applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined”

In determining the differences between the prior art and the claims, “the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP §2141.02, “Basic Considerations Which Apply to Obviousness Rejections,” *citing Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenk v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). (Emphasis added). The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. MPEP §2143 *citing In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, “[t]he requirement “at the time the invention was made” is to avoid impermissible hindsight.” MPEP §2141.01(III).

With respect to the person of ordinary skill in the art standard applied by the Office Action, it is particularly noted that “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” MPEP §2143.01, “The Prior Art Must Suggest the Desirability of the Claimed Invention,” *citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). In this regard, “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.” MPEP §2143.01, “The Prior Art Must Suggest the Desirability of the Claimed Invention,” *citing Al-Site Corp. v. VSI*

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*Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Furthermore, "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." MPEP §2143.01, "Fact That the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness," citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); and *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

First, the Applicants respectfully traverse the allegation in the Office Action that "variations in the configurations of the trough and set screw would have been a matter of engineering design choice, being a rearrangement of parts without patentable significance" (citing *In re Harza*, 274 F.2d 669 (CCPA 1960)). That is, the Office points to *In re Harza* as providing the teaching, suggestion, or motivation to combine the cited references set forth in the obviousness rejections of the pending claims, and this allegation is traversed by the Applicants.

The Applicants note that the Office previously cited *In re Japikse* (found at 181 F.2d 1019 (CCPA 1950) in the previous Office Action, at the citation now associated with *In re Harza*. In response to the previous Office Action, the Applicants submitted that *In re Japikse* did not involve an assessment of patentable significance as it related to the rearrangement of parts as a matter of engineering design choice, as alleged in the Office Action. That is, *In re Japikse* involved a situation where the appellant attempted to overcome a basic reference patent cited in an obviousness rejection by alleging inoperativeness of the basic reference patent. In that case, the CCPA ruled that the alleged inoperativeness could be cured by an obvious matter of design and, as such, the basic reference patent could not be eliminated on the ground of inoperativeness. On this basis, the Applicants submitted that *In re Japikse* was not relevant to the present application since the Applicants did not seek to eliminate the Mooney '052 reference on the basis of inoperativeness.

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Presuming that *In re Harza*, 274 F.2d 669 (CCPA 1960) is now the citation actually being cited by the Office, the Applicants further submit that *In re Harza* **does not** involve an assessment of patentable significance as it related to the rearrangement of parts as a matter of engineering design choice, as alleged in the Office Action. That is, the decision in *In re Harza* involves affirmation of a rejection of a claim based upon "the mere duplication of parts" having "no patentable significance unless a new and unexpected result is produced." The rejection of other claims was also affirmed since functional language in those claims was not considered to be of patentable significance. **Nowhere in the *In re Harza* decision does the CCPA make reference to an assessment of patentable significance as it related to the rearrangement of parts as a matter of engineering design choice, as alleged in the Office Action.** Further, the Applicants submit that ***In re Harza* is not relevant** to the present application since the issues in the rejections **do not** include a mere duplication of parts without patentable significance or an argument for patentability based upon functional language within a claim.

Thus, the Applicants assert that ***In re Japikse* and *In re Harza* do not make any reference to an assessment of patentable significance as it related to the rearrangement of parts as a matter of engineering design choice, as alleged in the Office Action.** As such, since ***In re Japikse* and *In re Harza* do not** stand for the proposition alleged in the Office Action, the Applicants submit that ***In re Japikse* and *In re Harza* cannot** provide the motivation to combine the references cited in the Office Action.

Even though ***In re Japikse* and *In re Harza* do not** provide the motivation to combine the references cited in the Office Action, the Applicants still traverse the Office's characterization of the present invention as merely involving "a rearrangement of parts" associated with the configuration of the trough and set screw. That is, it appears that the Office considers the particular recitation of the trough and set screw in relation to the clamping member(s) as a "mere rearrangement of parts" and, in doing so, is alleging that any secondary reference showing a "trough" that could possibly be oriented in a particular manner is sufficient to obviate the claims currently pending. However, MPEP §2141.02(1) particularly notes that "[I]n determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences **themselves** would have been obvious, but



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whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)." In this alleged characterization of the Applicants' claimed invention, the Applicants submit that the Office Action is evaluating a "gist" or "thrust" of present invention, instead of particularly considering the combination of elements, as a whole. In this regard, MPEP §2141.02(II) notes that "[d]istilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)." That is, the Applicants submit that the focus of the Office Action solely on the configuration of the trough and set screw is in direct contravention to a basic tenet of patent law set forth in MPEP §2141, which explicitly states that, when "applying 35 U.S.C. 103 . . . the claimed invention must be considered as a whole."

The Applicants respectfully assert that, in applying the cited references to the embodiments of the present invention as now claimed in Claims 9 and 18, the claimed invention must be considered as a whole. As now amended, Claims 9 and 18, **AS A WHOLE**, particularly recite a clamping apparatus, for securing a first ground wire parallel to a grounding member, having discrete top and bottom clamping members joinable through aligned holes disposed along respective first and second longitudinal axes, and a trough integral with the top clamping member opposite the bottom clamping member, wherein a first side wall of the trough defines a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes. The Applicants thus assert that the applicable inquiry in an obviousness analysis is whether the combination of references teaches or suggests a clamping apparatus for securing a first ground wire parallel to a grounding member, having a trough integral with the top clamping member, wherein a first side wall of the trough defines a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the discrete top and bottom clamping members together. The Specification of the present

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application notes that such a configuration provides, for example, a "laid in" capability for the ground wire after the clamp has been installed on a ground member.

In this regard, the Mooney '052, Reichman '198, Churla '374, and Meinhardt '108 patents, when each is considered as a whole (as also required under MPEP §2141), **do not teach or suggest, either individually or in combination, the claimed invention as a whole.**

However, before addressing the references cited in the Office Action, the Applicants traverse the Office's allegation that the Applicants' arguments target the references *individually* to show nonobviousness, for the following reasons. MPEP §2141.02(VI) recites that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, MPEP §§2142 and 2143 note that, "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). MPEP §2143.01(III) notes that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

In this regard, the Applicants assert that **an examination of the teachings of the secondary reference(s), each as a whole, is a necessary aspect of addressing an obviousness rejection.** That is, **in an obviousness rejection, each of the references must be examined in its entirety to determine what that reference discloses or does not disclose with respect to a suggestion or motivation to modify the reference or to combine reference teachings (i.e., determine whether there is a teaching or suggestion to make the claimed combination).**

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With respect to the references cited in the Office Action, the Mooney '052 patent discloses a stamp-formed ground clamp having opposing clamping sections, wherein one of the clamping sections includes a cable clamp, formed from the stamping, having a horizontal leg above the clamping section, wherein the leg includes a tapped vertical bore engaged by a cable clamping screw. As such, the Mooney '052 patent discloses a configuration whereby the "tapped vertical bore" extends parallel to the holes for securing the clamping sections together. Since the Mooney '052 patent does not objectively teach or suggest a clamping apparatus having a trough integral with the top clamping member for securing a first ground wire parallel to a grounding member, wherein a first side wall of the trough defines a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the discrete top and bottom clamping members together, such an objective teaching or suggestion of this deficiency must necessarily be found in the secondary reference(s) in order to sustain an obviousness rejection. The Applicants evaluation of the secondary references is then necessarily directed to demonstrating that the secondary references do not teach or suggest a trough integral with the clamping member, wherein the trough is integrated such that a first side wall of the trough defines a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the discrete top and bottom clamping members together.

In this regard, the Reichman '198 patent discloses a monolithic ground bushing having an associated wire clamping member that is "locked to the collar at the selected orientation by a bolt engaging the collar and clamp member rear wall bores." That is, the Reichman '198 discloses a wire clamping member that is purposely discrete from the ground bushing and is attachable thereto by a bolt such that the orientation of the wire clamping member can be changed. As previously discussed, the Mooney '052 patent discloses a configuration whereby a cable clamp "stamped and shaped from the web" forming an upper clamp section includes a "tapped vertical bore" that extends parallel to the holes for securing the clamping sections

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together. Accordingly, the Mooney '052 patent does not objectively teach or suggest a clamping apparatus having a trough integral with the top clamping member for securing a first ground wire parallel to a grounding member, wherein a first side wall of the trough defines a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the discrete top and bottom clamping members together. The Reichman '198 patent discloses a wire clamping member that is removable from the discrete monolithic ground bushing and, when installed on the respective monolithic ground bushing, may be rotated into different orientations. As such, the Reichman '198 patent does not teach or suggest that the wire clamping member can be incorporated as an integral part of the ground bushing. Further, the ground bushing disclosed by the Reichman '198 patent does not include separate portions joined together through first and second holes defining respective axes. The Reichman '198 patent, not being faced with the situation of incorporating the wire clamping member into a clamp having opposing portions secured together by screws, does not address the consideration of orienting the wire clamping member with respect to the screws joining the separate portions of the clamp together. Since one of the bases of the Reichman '198 patent is the concept of a selectively oriented wire clamping member, the Applicants submit that the Reichman '198 patent is not pertinent secondary art in this instance, as amended Claims 9 and 18 particularly recite that the trough is integral with the clamping member. As such, the Reichman '198 patent does not teach or suggest an integral trough having a first side wall defining a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the discrete top and bottom clamping members together.

The Office Action inasmuch admits that the Mooney '052 patent does not teach or suggest an integral trough configured to have a first side wall defining a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the

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first and second longitudinal axes used to join the discrete top and bottom clamping members together. Such a teaching or suggestion must therefore be provided by the Reichman '198 patent to sustain the obviousness rejection. Therefore, the Applicants' submission that the Reichman '198 patent does not provide such a teaching or suggestion is, in fact, addressing the combination of the cited references and is not "attacking references individually." The Applicants thus submit that the embodiments of the present invention as now claimed in Claims 9 and 18 are not taught or suggested by the Mooney '052 and Reichman '198 references, either separately or in combination. The act of replacing the integral cable clamp of Mooney with the discrete and selectively oriented cable clamping member of Reichman in a particular orientation, as alleged in the Office Action, amounts to a purely mechanistic combination of the cited references, and ignores the particularly recited limitations in the pending claims, as well as the direction of MPEP §2143.01(IV), which notes that an assertion that the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

The Office Action further cites the Meinhardt '108 patent as a secondary reference in the obviousness rejection over the Mooney '052 patent. In this regard, the Meinhardt '108 patent also discloses a monolithic ground bushing having an associated grounding lug that "can be easily connected with a screw" to any one of a plurality of inclined bosses spaced apart about the bushing, no matter where the bushing tightens down on the conduit. That is, the Meinhardt '108 discloses a ground lug that is purposely discrete from the bushing and is attachable by a screw to any of a plurality of bosses about the bushing. All embodiments show the ground lug being attached to the bushing such that the grounding conductor is perpendicular to the conduit. As previously discussed, the Mooney '052 patent discloses a configuration whereby a cable clamp "stamped and shaped from the web" forming an upper clamp section includes a "tapped vertical bore" that extends parallel to the holes for securing the clamping sections together. Accordingly, the Mooney '052 patent does not objectively teach or suggest a clamping apparatus having a trough integral with the top clamping member for securing a first ground wire parallel to a grounding member, wherein a first side wall of the trough defines a

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threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the *discrete* top and bottom clamping members together. The Meinhardt '108 patent discloses a ground lug that is removable from the discrete monolithic bushing and, when installed on the respective monolithic bushing, could possibly (though not disclosed) be rotated into different orientations. As such, the Meinhardt '108 patent does not teach or suggest that the ground lug can be incorporated as an integral part of the bushing. Further, the bushing disclosed by the Meinhardt '108 patent does not include separate portions joined together through first and second holes defining respective axes. The Meinhardt '108 patent, not being faced with the situation of incorporating the ground lug into a clamp having opposing portions secured together by screws, does not address the consideration of orienting the ground lug with respect to the screws joining the separate portions of the clamp together. Since one of the bases of the Meinhardt '108 patent is the concept of a ground lug that can be selectively fastened to conduit bushing, the Applicants submit that the Meinhardt '108 patent is not pertinent secondary art in this instance, as amended Claims 9 and 18 particularly recite that the trough is integral with the clamping member. As such, the Meinhardt '108 patent does not teach or suggest an integral trough having a first side wall defining a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the *discrete* top and bottom clamping members together.

As previously discussed, the Office Action inasmuch admits that the Mooney '052 patent does not teach or suggest an integral trough configured to have a first side wall defining a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the *discrete* top and bottom clamping members together. Such a teaching or suggestion must therefore be provided by the Meinhardt '108 patent to sustain the obviousness rejection. Therefore, the Applicants' submission that the Meinhardt '108 patent does not provide such a teaching or suggestion is, in

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fact, addressing the combination of the cited references and is not "attacking references individually." The Applicants thus submit that the embodiments of the present invention as now claimed in Claims 9 and 18 are not taught or suggested by the Mooney '052 and Meinhardt '108 references, either separately or in combination. The act of replacing the integral cable clamp of Mooney with the discrete ground lug of Meinhardt in a particular orientation, as alleged in the Office Action, amounts to a purely mechanistic combination of the cited references, and ignores the particularly recited limitations in the pending claims, as well as the direction of MPEP §2143.01(IV), which notes that an assertion that the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

The Office Action also cites the Churla '374 patent as a secondary reference in the obviousness rejection over the Mooney '052 patent. In this regard, the Churla '374 patent also discloses a monolithic ground bushing having an integral electrical clamp cast as an integral unit of metal, wherein the electrical clamp is oriented with respect to the bushing such that the electrical conductor received by the electrical clamp is oriented perpendicularly to the pipe on which the bushing is installed. As previously discussed, the Mooney '052 patent discloses a configuration whereby a cable clamp "stamped and shaped from the web" forming an upper clamp section includes a "tapped vertical bore" that extends parallel to the holes for securing the clamping sections together. Accordingly, the Mooney '052 patent does not objectively teach or suggest a clamping apparatus having a trough integral with the top clamping member for securing a first ground wire parallel to a grounding member, wherein a first side wall of the trough defines a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the discrete top and bottom clamping members together. The Churla '374 patent discloses an electrical clamp that is integral with the discrete monolithic bushing, but wherein the electrical conductor received by the electrical clamp is oriented perpendicularly to the pipe on which the bushing is installed. The bushing disclosed by the Churla '374 patent does not

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include separate portions joined together through first and second holes defining respective axes. The Churla '374 patent, not being faced with the situation of incorporating the electrical clamp into a clamp having opposing portions secured together by screws, does not address the consideration of orienting the electrical clamp with respect to the screws joining the separate portions of the clamp together. As such, the Churla '374 patent does not teach or suggest an integral trough for securing a first ground wire parallel to a grounding member, and having a first side wall defining a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the discrete top and bottom clamping members together.

As previously discussed, the Office Action inasmuch admits that the Mooney '052 patent does not teach or suggest an integral trough configured to have a first side wall defining a threaded hole extending along a third axis through the first side wall and toward the second side wall, with the third axis intersecting at least substantially perpendicularly with at least one of the first and second longitudinal axes used to join the discrete top and bottom clamping members together. Such a teaching or suggestion must therefore be provided by the Churla '374 patent to sustain the obviousness rejection. Therefore, the Applicants' submission that the Churla '374 patent does not provide such a teaching or suggestion is, in fact, addressing the combination of the cited references and is not "attacking references individually." The Applicants thus submit that the embodiments of the present invention as now claimed in Claims 9 and 18 are not taught or suggested by the Mooney '052 and Churla '374 references, either separately or in combination. The act of replacing the integral cable clamp of Mooney with the integral electrical clamp of Churla in a particular orientation (i.e., using the electrical clamp of Churla in a different orientation), as alleged in the Office Action, amounts to a purely mechanistic combination of the cited references, and ignores the particularly recited limitations in the pending claims, as well as the direction of MPEP §2143.01(IV), which notes that an assertion that the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.



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The Applicants again note that MPEP §2143 states that "[t]he teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." In this regard, the Reichman '198 and Meinhardt '108 patents each disclose a wire clamping member that is discrete, nonintegral, and movable with respect to a monolithic ground bushing. That is, the wire clamping member disclosed in each of the Reichman '198 and Meinhardt '108 patents is removable from the respective monolithic ground bushing and, when installed on the respective monolithic ground bushing, may be rotated into different orientations. As such, the Applicants submit that the Mooney '052, Reichman '198 and Meinhardt '108 patents, either separately or in combination, do not teach or suggest applying such movable and selectively oriented wire clamping members as disclosed by the Reichman '198 and Meinhardt '108 patents to an electrical conduit grounding device as disclosed by the Mooney '052 patent. Further, the Reichman '198 and Meinhardt '108 patents do not teach or suggest how such movable and selectively oriented wire clamping members could be applied to an electrical conduit grounding device having an integral cable clamp formed through the stamping process required by the Mooney '052 patent.

Further, the Churla '374 patent discloses a wire clamping member that is integrally formed with respect to a monolithic ground bushing in such a manner that the wire received thereby is oriented perpendicularly to the conduit on which the monolithic ground bushing is received. That is, the "side walls" defining the wire clamping member are spaced apart along the axis of the monolithic ground bushing along which the conduit is received. As such, the Applicants submit that the Mooney '052 and Churla '374 patents, either separately or in combination do not teach or suggest applying an integrally formed wire clamping member, configured such that the wire received thereby is oriented perpendicularly to the conduit on which the monolithic ground bushing is received, to an electrical conduit grounding device as disclosed by the Mooney '052 patent, and neither patent discloses how such a wire clamping member oriented perpendicularly to the conduit-receiving direction could be formed using the stamping process required by the Mooney '052 patent.

In any instance, the Mooney '052, Reichman '198, Churla '374, and Meinhardt '108 patents, either separately or in combination, do not teach or suggest the combination of

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elements comprising the clamping apparatus as now claimed in independent Claims 9 and 18. These deficiencies of the Mooney '052, Reichman '198, Churla '374, and Meinhardt '108 patents are also applicable with respect to the rejections of Claims 14 and 23, additionally over the Bondeson '776 patent, as well as with respect to the rejections of Claims 16 and 26, additionally over the Shemtov '859 patent and the rejections of Claims 15 and 25, additionally over the Perera '844 patent, since Claims 14-16 depend from Claim 9, while Claims 23-26 depend from Claim 18. As such, the Applicants submit that Claims 9, 11-23, and 25-27 are patentable over the Mooney '052, Reichman '198, Churla '374, Meinhardt '108, Bondeson '776, Shemtov '859, and Perera '844 patents cited in the Office Action.


### Conclusion

In summary, the Mooney '052, Reichman '198, Churla '374, Meinhardt '108, Bondeson '776, Shemtov '859, and Perera '844 patents do not teach, suggest, or provide motivation for the embodiments of the present invention, as now claimed in Claims 9 and 18. Accordingly, in view of these differences between the Applicants' invention and the Mooney '052, Reichman '198, Churla '374, Meinhardt '108, Bondeson '776, Shemtov '859, and Perera '844 patents, it is submitted that the present invention, as defined by Claims 9, 11-23, and 25-27, is patentable over the prior art cited in the Office Action. As such, for the reasons set forth above, Claims 9, 11-23, and 25-27 are believed to be in condition for immediate allowance. Accordingly, notice to such effect is respectfully requested at the Examiner's earliest opportunity.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

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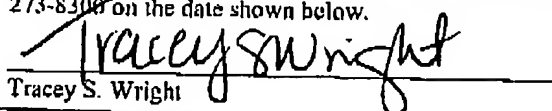
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